

REMARKS

Claims 1-31 were pending in this Application as of the Decision on Appeal mailed April 8, 2011. Claims 1, 13, 15, 18, 26, 28, and 31 are respectfully amended with this Response. Claims 11, 14, 16, 24, 27, and 29 are respectfully cancelled. An RCE entering this Response is respectfully attached herewith.

The rejections on appeal set forth at page 2 of the Decision on Appeal mailed April 8, 2011 will be addressed hereinbelow.

Claim Rejections Under 35 U.S.C. §103(a)

Claims 1-3, 6, 9-20, and 22-30 have been rejected under 35 U.S.C. §10a(a) as being obvious over Kelly et al. U.S. Patent No. 6,006,482 hereinafter referred to as “Kelly.”

Applicant’s claims 1 and 18 recite *inter alia*:

“a secondary waterproof membrane loose laid over said energy absorbing layer, such that said waterproof membrane is completely unattached to any portion of the roof system at any area of said waterproof membrane running substantially parallel to a relatively upper surface of said frangible energy absorbing layer, said waterproof membrane only being attached to the roof system at an area of the waterproof membrane running substantially perpendicular to said relatively upper surface of said frangible energy absorbing layer;

_____ at least one intentional wrinkle disposed over an open area of said relatively upper surface of said frangible energy absorbing layer that is absent any attachment structure, adhesive, or other structure protruding upwardly from said relatively upper surface of said frangible energy absorbing layer relative to a substantial remainder of said relatively upper surface of said frangible energy absorbing layer, said open area between said waterproof membrane and said relatively upper surface of said frangible energy absorbing layer at said wrinkle allowing said waterproof membrane to be pulled down towards said relatively upper surface of said frangible energy absorbing layer in response to hail impact upon the waterproof membrane without interference from any attaching to said relatively upper surface of said frangible energy

absorbing layer or structure between said waterproof membrane and said relatively upper surface of said frangible energy absorbing layer.”

Kelly does not teach a secondary waterproof membrane *loose laid* over said energy absorbing layer as is now claimed. Instead, referring to Figures 1, 15 25, and 30, the waterproof membrane over the frangible layer(s) is attached via screw and/or adhesive to an area of the system running substantially parallel to a relatively upper surface of the frangible layer(s).

In addition, Kelly fails to teach a wrinkle disposed in the waterproof membrane as claimed. Instead, referring to Figures 1, 15, and 25, Kelly teaches an alleged wrinkle that is adhered, attached, or disposed over an upwardly protruding structure, preventing pulling the waterproof membrane towards the frangible layer(s) without interference.

For at least the reasons set forth above, Applicant respectfully asserts that Kelly does not teach every element of Applicant’s claim 18, or claims 19 and 20 that depend therefrom. Accordingly, Applicant respectfully submits that Kelly does not anticipate claims 18-20.

Referring to claim 17, Applicant recites

“a layer of stiff material attached to said roof deck; [and] a primary waterproofing membrane supported by said stiff material.”

Applicant respectfully notes that the Decision on Appeal does not address the above element of Applicant’s claim 17, as set forth at Applicant’s pages 16 and 17 of the Appeal Brief. Accordingly, Applicant respectfully reiterates the argument that Kelly does not teach a layer of stiff material attached to a roof deck or a primary waterproofing membrane supported by this stiff material. First Applicant points out that the layer 110, which the Examiner equates with Applicant’s “layer of stiff material,” is taught in Kelly as a gravel layer 110. In Kelly, this gravel 110 is not taught to be “attached” to anything, but is instead taught to be disposed between layers of insulation 14. As shown in Figure 31, the gravel 110 does not contact the deck 12 (insulation of the BUR 108 being disposed between the deck 12 and the gravel 110), and thus, the gravel layer 110 is not “attached” to the deck 12. Applicant respectfully points out that the gravel 110, due to its nature, could not be “attached” to the deck 12 via the mechanical fastener 20.”

Referring to “the primary waterproofing layer supported by the stiff material,” the Examiner equates this layer of Applicant’s claim 17 with “the layer 14 directly above layer 10” (see page 3 of the Office Action) in Figure 31 of Kelly. However, referring to column 11 lines 7-9, Kelly teaches this layer to be an insulation layer included in the built up roof (BUR) 108. Applicant respectfully submits that it is well known in the art that an insulation layer would not function as a waterproofing layer, as it typically consists of such non-waterproofing materials as gypsum, fiberboard, and wood (see column 5 line 54 of Kelly). Applicant points to Kelly’s inclusion of an actual waterproofing membrane 9 as further evidence that the insulation layers 14 (and the insulation layer of 108) of Kelly are not taught for waterproofing purposes.

For at least this reason, Applicant respectfully asserts that Kelly does not teach every element of Applicant’s claims 1-3, 6, 9-20, and 22-30. Accordingly, Applicant respectfully submits that claims 1-3, 6, 9-20, and 22-30 are not obvious over Kelly.

Claims 4-5 have been rejected over Kelly in view of United States Patent No. 6,250,036 to Nurley (“Nurley” hereinafter).

As claims 4 and 5 depend from claim 1, and as Nurley fails to remedy the above-discussed deficiencies of Kelly as they relate to claim 1, Applicant respectfully submits that claims 4 and 5 are not obvious over the proposed combination of Kelly and Nurley.

Claims 7-8, 21, and 31 have been rejected over Kelly in view of United States Patent No. 6,006,482 to Bennett (“Bennett” hereinafter), and Kelly in view of Bennett, in view of Pearson.

As claims 7-8 and 21 depend from claims 1 and 18, and as Bennett fails remedy the above-discussed deficiencies of Kelly as they relate to claims 1 and 18, Applicant respectfully submits that claims 7-8 and 21 are not obvious over the proposed combination of Kelly and Bennett.

In addition, and similarly to claims 1 and 18, claim 31 recites, *inter alia*,

“a loose laid, non-reinforced waterproofing membrane with fabricated wrinkles disposed upon said gypsum board, such that said waterproof membrane is completely unattached to any portion of the roof system at any area of said waterproof membrane running substantially parallel to a relatively upper surface of said gypsum board, said waterproof membrane only being attached to the roof system at an area of the waterproof membrane running substantially perpendicular to said relatively upper surface of said gypsum board,

 wherein said wrinkles are disposed over an open area of said relatively upper surface of said gypsum board that is absent any attachment structure, adhesive, or other structure protruding upwardly from said relatively upper surface of said gypsum board relative to a substantial remainder of said relatively upper surface of said gypsum board, said open area between said waterproof membrane and said relatively upper surface of said gypsum board at said wrinkle allowing said waterproof membrane to be pulled down towards said relatively upper surface of said gypsum board in response to hail impact upon the waterproof membrane without interference from any attaching to said relatively upper surface of said gypsum board or structure between said waterproof membrane and said relatively upper surface of said gypsum board.”

For at least the above discussed reasons, the proposed combination of Kelly and Bennett does not teach the above quoted element of claim 31.

Conclusion

All of the rejections are herein overcome. No new matter is added by way of the present Remarks, as support is found throughout the original filed specification, claims, and drawings. Notice of Allowance is respectfully requested.

If the Examiner has any questions regarding the instantly submitted response, Applicant's attorney respectfully requests the courtesy of a telephone conference to discuss any matters in need of attention.

Applicant hereby petitions for any necessary extension of time required under 37 C.F.R. 1.136(a) or 1.136(b) which may be required for entry and consideration of the present Reply.

If there are any additional charges with respect to this response or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorney.

Respectfully submitted,
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